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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,103	01/12/2001	Scott Clark	10567-003	1839

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EXAMINER

LAstra, DANIEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,103

Applicant(s)

CLARK ET AL.

Examiner

DANIEL LASTRA

Art Unit

3622

mw

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-19 have been examined. Application 09/759,103 (SEARCH ENGINE PROVIDING AN OPTION TO WIN THE ITEM SOUGHT) has a filing date 01/12/2001.

Response to Amendment

2. In response to Office Action dated 12/29/03, Applicant amended claims 1-5 and added new claims 6-19. Applicant amendment overcame the previous §112 rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitation "providing the user" and "product or service for the user". There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 10, the phrase "may be" renders the claim(s) indefinite because the claim(s) refer to the potential of the action and leaves in doubt whether the action is encompassed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 7, 8, 10, 12, 13, 15, 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al (U.S. 6,443,843).

As per claim 10, Walker teaches:

A method of providing a user with a game of chance, the method comprising:

receiving electronic signals representing at least one search parameter descriptive of a product (see column 4, lines 1-35; column 13, line 60 – column 14, line 2);

transmitting electronic signals representing at a least one product, a price of the product and a third-party dealer of the product (see column 3, lines 44-48; column 4, lines 1-35);

transmitting electronic signals representing at least a first option to play a game to win the product, and a second option to purchase the product (see column 13, line 60 – column 14, line 50; column 16, lines 50-60);

if the user opts to play the game:

electronically calculating a probability of winning the product; electronically generating a pseudo-random outcome having a probability corresponding to the calculated probability (see column 2, lines 36-55; column 14, lines 10-35); and

based on the pseudo-random outcome, purchasing the product for the user (see column 4, lines 21-32; column 19, lines 1-18);

and

if the user opts to purchase the product:

directing the user to a web site where the product may be purchased (see column 13, line 60 – column 14, line 10);

wherein the user is permitted to play the game and win the product without paying a fee (see column 19, lines 5-9; column 2, lines 10-18)

As per claim 12, Walker teaches:

The method of claim 10, comprising calculating a probability of winning based on at least a current budget (see column 14, lines 50-61).

As per claim 13, Walker teaches:

The method of claim 10, comprising calculating a probability P of winning based on a total number of game players (see column 14, lines 50-61).

Claim 15 contains the same limitation as claim 10 therefore the same rejection is applied.

Claim 17 contains the same limitation as claim 12 therefore the same rejection is applied.

Claim 18 contains the same limitation as claim 13 therefore the same rejection is applied.

Claim 1 contains the same limitations as claim 10 therefore the same rejection is applied.

As per claim 2, Walker teaches:

The *method* of claim 1, wherein the probability is calculated so as to increase with the value derived from the user's interaction with the system (see column 2, lines 35-55; column 11, lines 30-49).

Claim 7 contains the same limitation as claim 12 therefore the same rejection is applied.

Claim 8 contains the same limitation as claim 13 therefore the same rejection is applied.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 6,443,843).

As per claim 14, Walker teaches:

The method of claim 10, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

where:

Walker does not expressly teach P_a is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that as the value of a prize approaches the total budget of a game of chance system, the more difficult would be the probability of winning a grand prize (see column 17, lines 39-45).

Pt is a probability factor that varies with a current prize budget (see column 16, lines 18-31);

Pm is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received (see column 16, lines 17-31);

Pu is probability factor that varies with the user's behavior (see column 11, lines 40-49); and

N is a number of current users (see column 14, lines 50-61).

Claim 19 contains the same limitation as claim 14 therefore the same rejection is applied.

Claim 9 contains the same limitation as claim 14 therefore the same rejection is applied.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 6,443,843) in view of Yoseloff (U.S. 6,331,143).

As per claim 3, Walker fails to teach:

The *method* of claim 2, wherein the outcome is indicated by displaying a user chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number. However, Yoseloff teaches about a system where a player selects a number and the system generates a random number, and a winning outcome is indicated if the user-chosen number matches the system generated random number (see column 8, lines 35-50; column 7, lines 50-64; column 3, lines 35-62). Therefore, it

would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Walker system would allow customers to play a game where the user would choose a number and the system would generate a random number, and where the customer would win a prize when the user-chosen number matches the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games, without losing anything if the customer does not receive a winning outcome.

As per claim 4, Walker fails to teach:

The *method* of claim 3, wherein an increased probability of winning is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number. However, Yoseloff teaches about the different probabilities associated with matching a one or more digits number chosen by a user with a random number generated by a system (see column 8, lines 6-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a user would use the Walker system would select a product and would play a game to have the opportunity to win the product and to win the game and the product the user would choose a number and the system would generate a random number where the winning outcome would be determined if at least one digit of the user-chosen number matches at least one digit of the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity

to win products by playing games without losing anything if the customer does not receive a winning outcome.

As per claim 5, Walker fails to teach:

The *method* of claim 3, wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number. However, Walker teaches that the probability of receiving a winning outcome varies with customers, where loyal customers would have a higher probability of receiving a winning outcome and winning the product than other customers that are not as loyal to the provider of the products (see column 2, lines 35-55; column 11, lines 30-49). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would vary the probability of receiving a winning outcome based upon the customers loyalty to the retailer and, therefore, the probability of winning the game would be different than one calculated with probabilistic method such as one divided by ten raised to the power of the number of digits in the comparison number. Walker would give a higher probability of winning the game to a loyal customer to thank him or her for being a loyal customer, which would serve as an incentive to continue visiting the shop.

Claims 6, 11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 6,443,843) in view of Goldberg et al (U.S. 6,183,366) and further in view of Abecassis (U.S. 6,553,178).

As per claim 11, Walker fails to teach:

The method of claim 10, comprising providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation. However, Goldberg teaches a network gaming system where users are compensated for viewing advertisements by allowing them to play various games (see abstract). Also, Abecassis teaches that "The viewer is compensated for the verified apparent viewing of the selected advertisement independently of the purchase of the advertised product or service. Where the advertisement is associated with a credit, the viewing of the advertisement subsidizes the viewer's receipt of other video and communication devices. Where a viewing of video results in a purchase, a deposit in the purchase is automatically escrowed until after the buyer has received satisfactory delivery of the purchase" (see abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users of the Walker system would be compensated for the viewing of selected sponsors' advertisements independently of the purchase of the advertised product or service, as taught by Abecassis and these compensations would provide users with various game, as taught by Goldberg, that would be used to play to win the sponsors' advertise products, as taught by Walker. Compensating users for viewing advertisements would be a good business decision as this would increase the probability that users would view the sponsors' advertisements and would play to win the advertise products, therefore increasing customer traffic and customer loyalty (see Walker, column 2, lines 7-18).

Claim 6 contains the same limitation as claim 11 therefore the same rejection is applied.

Claim 16 contains the same limitation as claim 11 therefore the same rejection is applied.

Response to Arguments

6. Applicant's arguments filed 03/26/04 have been fully considered but they are not persuasive. Applicant argues that in the invention of claim 1, the user is not charged a fee and that this differs from both Walker and Yoseloff, which both require a user to pay a wager. The Examiner answers that because Applicant's specification is silent about fees, the Examiner would consider the added amended feature of "without paying a fee", as new matter. Walker teaches in column 19, lines 1-8, the request to play a game to win a selected product, where is not necessary to pay a fee. Also, Walker teaches in column 12, lines 42-62 that the fee paid is credited back to the customer, if a lose or a win outcome is obtained. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would allow customers to play games to win selected products without paying a fee. The fee paid may be determined by the customer, which will determine a probability that the game will result in a winning outcome. The higher the fee paid, the higher the probability of receiving a winning outcome, where playing without paying a fee would result in having the lowest probability of receiving a winning outcome.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

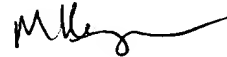
Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel Lastra
May 20, 2004



MELANIE A. KEMPER
PRIMARY EXAMINER